

REMARKS

Claims 1-9 are pending in this application. The Office Action withdraws claims 6-9 as drawn to a non-elected invention; rejects claim 1 under 35 U.S.C. §112, second paragraph; and rejects claims 1-5 under 35 U.S.C. §102(b). By this Amendment, claim 1 is amended. No new matter is added.

I. Rejection under 35 U.S.C. §112, second paragraph

Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Specifically, the Office Action alleges that the phrases "the one in which zirconium" and "the elongation" lack antecedent basis. By this Amendment, claim 1 is amended to clarify the language used therein.

Reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejections under 35 U.S.C. §102(b)

A. Yamamoto

Claims 1-5 are rejected under 35 U.S.C. §102(b) as anticipated by Yamamoto (U.S. Patent No. 5,814,576). Applicants respectfully traverse the rejection.

Applicants respectfully submit that Yamamoto does not disclose each and every feature of independent claim 1. Specifically, Yamamoto at least fails to disclose that "an elongation of the crystal lattice due to the substitution with the element assumes a nearly theoretical value." The Office Action alleges that this feature would be inherent in the disclosure of Yamamoto, allegedly because "the zirconium oxide composition taught by Yamamoto is commensurate with claims 1-5, and would therefore be expected to have the same physical characteristics."

Applicants respectfully traverse this assumption. As is discussed in the present specification at least at page 8, lines 9-18, the "elongation of the crystal lattice due to the substitution with the element assumes a nearly theoretical value" is a result of the process by

which the claimed zirconium composite oxide is made. This process is discussed in the present specification at least at page 8, line 27 through page 13, line 36. Generally, this process uses the interaction between an organic phase and aqueous phase (such as in an emulsion) to form the zirconium composite oxide. This process "enables lanthanum to be substituted in a sufficiently large amount by zirconium" and "substitution by lanthanum in a sufficient amount is reflected by the fact that the elongation of the crystal lattice of the zirconium oxide due to the substitution with an element assumes a nearly theoretical value." See page 8, lines 10-18, of the present specification.

In contrast, zirconium oxides "produced by a conventional method of producing composite oxides, such as co-precipitation method or alkoxide method, [are] not capable of permitting lanthanum to be substituted with zirconium to a sufficient degree." See the present specification at page 8, lines 2-6. The comparative examples discussed in "Example 1" and "Example 2" on pages 46-47, and Figs. 28, also show how conventional oxides produced by the co-precipitation method do *not* achieve elongation of the crystal lattice having a nearly theoretical value. The present specification thus clearly describes and demonstrates that the claimed elongation of the crystal lattice is not an inherent characteristic of all zirconium composite oxides, but instead is dependent upon how the oxide is made.

Yamamoto discloses using the conventional co-precipitation method to form the oxide therein, at column 9, lines 4-22. The disclosure of Yamamoto is therefore equivalent to the comparative examples discussed in the present specification. Therefore, Yamamoto is *incapable* of achieving the presently claimed feature that "an elongation of the crystal lattice due to the substitution with the element assumes a nearly theoretical value." Under MPEP 2112, the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic, instead the evidence

must make clear that the missing descriptive matter is *necessarily* present. For the reasons discussed above, this feature *cannot* be present according to the disclosure of Yamamoto.

Accordingly, independent claim 1 is not anticipated by Yamamoto for at least the reasons discussed above. Dependent claims 2-5 therefore also are not anticipated for at least the reason that independent claim 1 is not anticipated.

Reconsideration and withdrawal of the rejection are respectfully requested.

B. Suzuki

Claims 1 and 3-5 are rejected under 35 U.S.C. §102(b) as anticipated by Suzuki (JP 2002-079097). Applicants respectfully traverse the rejection.

Applicants respectfully submit that Suzuki does not disclose each and every feature of independent claim 1. Specifically, Suzuki at least fails to disclose that "an elongation of the crystal lattice due to the substitution with the element assumes a nearly theoretical value." The Office Action makes no mention of this feature in the rejection over Suzuki. Therefore, Applicants can only assume that the Office Action implies that this feature would be inherent in the disclose of Suzuki, presumably for the same reason that this feature was alleged to be inherent in the disclose of Yamamoto (i.e. that the compositions are allegedly "commensurate" and therefore would be expected to have the same physical characteristics.) Applicants again respectfully traverse this assumption.

Similar as to what was discussed above, Suzuki also discloses that a conventional co-precipitation method is used to form the oxide therein. See Suzuki at paragraphs [0064] and [0065], "precipitate of hydroxylation cerium, zirconium hydroxide, and aluminum hydroxide was obtained." Therefore, as discussed above, Suzuki is equivalent to the comparative example discussed in the present specification, and is *incapable* of achieving the above discussed feature.

Accordingly, independent claim 1 is not anticipated by Suzuki for at least the reasons discussed above. Dependent claims 3-5 are therefore also not anticipated for at least the reason that independent claim 1 is not anticipated.

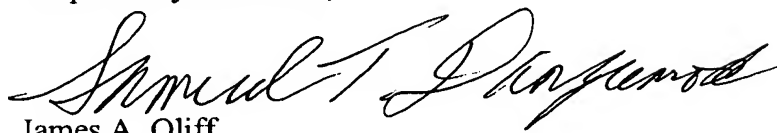
Reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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